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EXAMINER	
HENDRICKSON, STUART L	
ART UNIT	**PAPER NUMBER**
1754	

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10725225	Applicant(s) May
	Examiner Nedrick	Group Art Unit 1754

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 2/10/04.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-40 is/are pending in the application.

Of the above claim(s) 39,40 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-38 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claim(s) 1-40 are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)–(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)–(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO–1449, Paper No(s). _____

☒ Notice of Reference(s) Cited, PTO–892

☐ Notice of Draftsperson's Patent Drawing Review, PTO–948

☐ Interview Summary, PTO–413

☐ Notice of Informal Patent Application, PTO–152

☐ Other _____

Office Action Summary

Applicant's election with traverse of Group I in the reply filed on 12/10/04 is . acknowledged. The traversal is on the ground(s) that the searches overlap. This is not found persuasive because the searches are not congruent, and art applicable to group I may not be applicable to Group II. However, see in re Ochiai concerning rejoinder of claims.

The requirement is still deemed proper and is therefore made FINAL. Limiting the claims to the specie elected is requested.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8, 25, 28-36 and 38 are rejected under 35 U.S.C. 102(a) as being anticipated by Zhou et al article.

Zhou teaches, especially on pg. 234, making SiC nanofibers of 20-40 nm diameter by contacting carbon nanotubes with vaporized SiO. The figures show tangled, uniform, unfused tubes. Beta is taught on pg. 237. It is noted that claim 38 is merely a recitation of intended use and does not require any additional material; if amended to do so, it will be further restricted as a composition.

Claims 1-8, 25-36 and 38 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zhou et al article.

The reference does not teach the identical verbiage, nor the exact process parameters. However, no difference is seen due to the similarity of the product description to what is claimed.

Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhou taken with Nadkarni et al. 4915924 and Tennent 4663230.

Zhou differs in not teaching the temperature used, however Nadkarni teaches in columns 7 and 10 that essentially the same reaction may be performed at the claimed temperatures.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the temperatures of Nadkarni in the process of Zhou because doing so saves energy by requiring less heat.

Concerning claims 9 and 37, the product will be the same since the temperatures are the same. In so far as the carbon fiber starting material is not identically described by Nadkarni and Zhou- and differs from what is claimed- then it is noted that Tennent teaches the claimed fiber. Using it in the above process is an obvious expedient to provide the carbon fiber required in the above references.

Claims 1-8, 25-36 and 38 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gruber 3246950.

The reference teaches in columns 2 and 4 monocrystalline beta-SiC. The overlapping diameter renders the claims unpatentable; In re Malagari 182 USPQ 549. No differences are seen.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-14 and 17-29 of U.S. Patent No. 6841508. Although the conflicting claims are not identical, they are not patentably distinct from each other because the dependent claims explicitly recite Si and the independent claims patented encompass the presently claimed conditions.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (571) 272-1351.

Stuart Hendrickson
examiner Art Unit 1754